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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,549	04/18/2001	John N. Randall	RAND-37	9264
29106	7590	11/22/2005		
GROOVER & HOLMES BOX 802889 DALLAS, TX 75380-2889			EXAMINER KOCH, GEORGE R	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 11/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,549

Applicant(s)

RANDALL ET AL.

Examiner

George R. Koch III

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's has pointed out that election of group I, claims 1-12 in the reply filed on 4/11/2005 was "with traverse". Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1-7 and 19-22, the phrase "or similar substances" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05.

Applicant can use the language from the abstract, which includes "oil paints", "acrylics", and "textured paints". It is suggested that applicant use "textural paints" if applicant wants to claim the entire scope of textured paints.

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5. Regarding claims 8-12 and 23-24, the phrase "or similar substances" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05.

Applicant can use the language from the abstract, which includes "oil paints", "acrylics", and "textured paints". It is suggested that applicant use "textural paints" if applicant wants to claim the entire scope of textured paints.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 4, 6, 8, 12 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida (US Patent 5,932,012).

As to claim 1, Ishida discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas (Figure 1).

As to claim 3, Ishida discloses that the automated mechanism uses a syringe to deposit the paint (item 2).

As to claim 4, Ishida discloses an automated mechanism capable of depositing and redistributing oil paint or similar substances on a canvas (Figure 1).

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As to claim 6, Ishida discloses that the automated mechanism uses a syringe to deposit the paint (item 2).

As to claim 8, Ishida discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas comprising: an attachment mechanism (substrate attracting table 13) through which a canvas suitable for painting is capable of being held in place, a deposition mechanism (item 2) for depositing a selectable amount of material such as paint through a well defined opening (the hole of the syringe) onto a substrate capable of being a canvas which is held by the attachment mechanism, a motion control mechanism (items 15a, 15b, and 15c), attached to the deposition mechanism to move said deposition mechanism to a desired position with respect to the substrate, such as a canvas, and a control system (item 14 and Figure 3) which receives external data (from item 11a) describing an amount of given paint which is to be deposited at a predetermined position on the canvas and which controls the motion control system and paint deposition system.

As to claim 12, Ishida discloses that the automated mechanism uses a syringe, which is capable of being used to deposit paint (item 2).

Regarding claims 19-24, Ishida is capable of being used to create works of art, original or not.

8. Claims 1, 2, 4, 5, 7 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by McNeely (US 3,321,331)

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As to claim 1, McNeely discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas (Figure 1).

As to claim 2, McNeely is capable of moving in three dimensions.

As to claim 4, McNeely discloses an automated mechanism capable of depositing and redistributing oil paint or similar substances on a canvas (Figure 1).

As to claim 5, McNeely is capable of moving in three dimensions.

As to claim 7, McNeely discloses that the automated mechanism uses a brush to redistribute the oil coating (item 44).

Regarding claims 19-22, McNeely is capable of being used to create works of art, original or not.

9. Claims 1-6, 8, 12 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Penn (US 5,594,652)

Penn discloses an automated mechanism capable of depositing oil paint or similar substances on a canvas (Figure 1a).

As to claim 2, Penn is capable of moving in three dimensions (see column 8, lines 21-41).

As to claim 3, Penn discloses that the automated mechanism can use a syringe as an alternative to a printhead to deposit the substance (column 12, lines 46-58).

As to claim 4, Penn discloses an automated mechanism capable of depositing and redistributing oil paint or similar substances on a canvas (Figure 1a).

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As to claim 5, Penn is capable of moving in three dimensions (see column 8, lines 21-41).

As to claim 6, Penn discloses that the automated mechanism uses a syringe to deposit the substance (column 12, lines 46-58).

Regarding claims 19-24, Penn is capable of being used to create works of art, original or not.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida as applied to claim 8 above, and further in view of Barlage (US 5,859,775).

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Ishida discloses all of the elements of claim 8, and includes various driving motors (15a, 15b, and 15c) but is silent as to the presence of any additional structures such as the belts.

However, Barlage discloses that it is known to utilize belts and drive shafts in conjunction with the motors. One in the art would appreciate that these elements ensure proper translation of the substrate relative to the coating dispenser. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have utilized the belts in order to provide proper translation and positioning.

13. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida as applied to claim 8 above, and further in view of McNeely (3,321,331).

As to claims 9 and 10, Ishida does not suggest an additional implement, such as a brush, for spreading the coating material over the substrate.

McNeely discloses utilizing brushes (item 44) to spread and distribute a coating (sprayed from nozzles 66). McNeely discloses that these brushes ensure that substrate is properly coated (for example, see column 1, lines 13-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such brushes in order to properly apply and spread the coating.

Response to Arguments

14. Applicant's arguments filed 9/16/2005 have been fully considered but they are not persuasive.

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15. In response to applicant's argument that "or similar substances" is not indefinite, it is noted that MPEP 2173.04 recites

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

However, there is nothing in the claim that makes the scope clear, and applicants have indicated that they intend the invention to cover substances which of which they are not aware. Applicant's Remark 9/19/2005, pp 8, lines 1-7.

16. In response to applicant's argument that the claimed apparatus is not anticipated by the references because none of the references disclose the function of applying paint onto a canvas, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the apparatus as described in Ishida, Penn and McNeely, are all capable of applying paint to a canvas.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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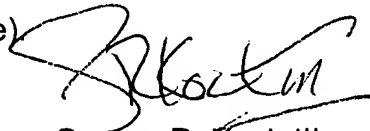
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and giving the operator the above TDD number. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)



George R. Koch III
Primary Examiner
Art Unit 1734

GRK
11/18/2005